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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,415	02/27/2004	Toru Yano	Q80109	4540

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT PAPER NUMBER

1712

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,415

Applicant(s)

YANO ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0504,0905.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 and 8-10 are rejected under 35 U.S.C. 102(a) as being anticipated by Kumazawa et al. (JP 2003-096285, See English Translation obtained from JPO Web-site).

For claim 1, the reference teaches mixtures of poly L-lactic acid and poly D-lactic acid in paragraph 12.

For claim 8, in paragraph [0024], the reference discloses mixed weight ratios that significantly overlap the range of amounts claimed by applicant.

For claims 2-4, the reference teaches that copolymers containing the lactic acid units may be formed where the units include polyols including polypropylene glycol and polybasic carboxylic acids. Paragraph [0028].

For claim 9, the reference teaches the use of molds that are heated. Paragraphs [0034]-[0035].

For claim 10, in paragraph [0045], the reference teaches a temperature of 100°

C.

3. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Nurmi et al. (U.S. Patent No. 6,881,876).

For claims 1 and 8, Nurmi teaches a fiber made up of a blend of 99% by weight L-poly lactide and 1% by weight of D-poly lactide. Col. 6, lines 9-12.

4. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hobbs et al. (U.S. Patent No. 6,645,618).

For claims 1 and 8, Hobbs teaches a fiber made up of a blend of equal amounts of L-poly lactide and D-poly lactide. Col. 5, lines 22-28.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumazawa et al. (JP 2003-096285, See English Translation obtained from JPO Website) as applied to claims 1 and 3 above, and further in view of Kondo et al. (U.S. Patent No. 5,593,778).

Kumazawa teaches the limitations of claims 1 and 3 as detailed above. Kondo fails to expressly teach the use of citric acid as a polybasic acid.

Kondo teaches biodegradable polyesters made of L-Lactic acid and D-Lactic acid used in fibers or films. See col. 5, line 20 through col. 6, line 11. In col. 23, line 53 through col. 24, line 12, Kondo teaches that copolymers of these polyesters may be produced through the use of other monomers such as citric acid.

Kondo and Kumazawa are analogous art in that they both teach lactic acid polymers as films or fibers where the polymers contain other units. It would have been obvious to one of ordinary skill in the art at the time of the invention to use citric acid as a polybasic carboxylic acid monomer. The motivation would have been that Kondo teaches that melt spinning is improved through the use of these monomers.

Allowable Subject Matter

7. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For claims 6 and 7, none of the references teach or suggest the use of a saccharide monomer in a blend of L-lactic acid and D-Lactic acid resins.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nyilas et al. (U.S. Patent No. 4,481,353), Matsui et al. (U.S.


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Patent No. 6,174,602), and Mohanty et al. (U.S. Patent No. 6,869,985) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR